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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/161,753  | 09/29/1998  | MICHAEL SUTHERLAND   | 024607-0022         | 8007             |
| 9629  | 7590        | 05/25/2004           | EXAMINER            |                  |
| MORGAN LEWIS & BOCKIUS LLP<br>1111 PENNSYLVANIA AVENUE NW<br>WASHINGTON, DC 20004 |             |                      | CASIANO, ANGEL L    |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2182                | 20               |
| DATE MAILED: 05/25/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                              |  |  |
|------------------------------|------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b>       | <b>Applicant(s)</b>                    |  |
|                              | 09/161,753                   | SUTHERLAND ET AL<br><i>[Signature]</i> |  |
|                              | Examiner<br>Angel L. Casiano | Art Unit<br>2182                       |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on 23 February 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 16-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 16-43 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
  1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### *Election/Restrictions*

1. Previous Election/Restriction (see first Office action) requirement has been withdrawn in view of applicant's arguments. All pending claims (16-43) have been examined.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 16-24 and 27-43 are rejected under 35 U.S.C. 102(e) as being anticipated by Teshima [US 6,272,470 B1].

Regarding claim 16, Teshima teaches a method for a medical system (see Figure 2). The cited system includes a medical scanner (see Figure 2, "12"), which scans a patient and creates medical image data and a computer workstation (see figure 2, "10") coupled to the scanner for analyzing the medical image data. The prior art method provides for utilization of new storage technology (see Figure 5, cols. 50-51). The cited method includes a peripheral-type removable

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medium recording station (see Figure 2, “13”; col. 7, lines 18-23). Medical image data is received from the system and stored in the storage media. Teshima also teaches medical image data in a first format (see “conversion”) and storing this data (see col. 3, lines 53-64). Stored data is *converted* into a second format (see col. 5, lines 51-57). The original format is compatible with the technologies implemented by the medical system (see col. 7, lines 5-17).

As per claim 17, the computer workstation is a digital imaging and communications in medicine compliant computer workstation (see DICOM; col. 4, line 29; col. 7, lines 7 and 8).

As for claim 18, the cited computer has a magneto-optical drive (see MO, Figure 2, “22”; col. 7, line 41).

As per claim 19, Teshima teaches a compact disk (see CD, Figure 2, “13”).

As for claim 20, Teshima exposes the used of a digital video disk (DVD, see col. 7, lines 42, 65).

As for claim 21, the cited art also teaches an additional storage device for *reading* medical image data and *copying* image data (see Figure 9, steps “145” to “152”).

As for claim 22, Teshima teaches conversion (see col. 12, line 64) in response to a determination regarding the size of the file (see Figure 9, “150”).

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As for claim 23, Teshima teaches *converting* medical data in response to a measure of the *utility* of the data (see Abstract, “filed *relevant* to the consultation record” and “conversion/producing element”).

As for claim 24, Teshima teaches removing and filing the removable medium (see Figure 1, “6”; col. 7, lines 1-4).

As for claims 27 and 28, the cited prior art teaches specialized image viewing software enabling DICOM (see col. 4, line 29; col. 7, lines 7-8).

Regarding claim 29, Teshima teaches a method for a medical image processing *network* (see Figure 1; col. 6, lines 46-48). The cited network includes a medical scanner (see Figure 2, “12”), which scans a patient and creates medical image data and a computer workstation (see figure 2, “10”) coupled to the scanner for analyzing the medical image data. The prior art provides for utilization of new storage technology (see Figure 5, cols. 50-51). The cited network includes a peripheral-type removable medium recording station (see Figure 2; col. 7, lines 18-23). Teshima discloses a server coupled to the network (see Figure 1). Medical image data is received from the system and stored in the storage media. Teshima also teaches medical image data in a first format (see “conversion”) and storing this data (see col. 3, lines 53-64). Stored data is *converted* into a second format (see col. 5, lines 51-57). The original format is compatible with the technologies implemented by the medical system (see col. 7, lines 5-17).

As per claim 30, the cited art also teaches an additional storage device for *reading* medical image data and *copying* image data (see Figure 9, steps “145” to “152”).

As for claim 31, the computer workstation is a digital imaging and communications in medicine compliant computer workstation (see DICOM; col. 4, line 29; col. 7, lines 7 and 8).

As for claim 32, the cited computer has a magneto-optical drive (see Figure 2, “22”; col. 7, line 41).

As per claim 33, Teshima teaches a compact disk (see Figure 2, “13”).

As for claim 34, Teshima exposes the used of a digital video disk (DVD, see col. 7, lines 42, 65).

Regarding claims 35-43, these are oriented to the removable medium recording station for the medical system. The prior art of record teaches the limitations corresponding to the method and network directed to the medical image processing system. Therefore, the prior art also teaches the removable medium recording station, which is recited as part of the medical system. These claims are rejected under the same basis.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teshima [US 6,272,470 B1] in view of Ballantyne et al. [US 5,867,821].

As for claim 25, Teshima does not teach the steps of *removing* and *filling* the removable medium as implemented using a *removable medium jukebox*. Teshima however, does teach a removable medium as part of its method for a medical system. Regarding this limitation, Ballantyne et al. teaches a method for accessing and distributing medical data. The cited art teaches the use of storage jukeboxes. Accordingly, as the cited reference teaches, one of ordinary skill at the time of the invention would have been motivated to combine the cited disclosures in order to provide appropriate storage for a variety of removable media.

As for claim 26, Teshima does not explicitly teach *labeling* the removable medium with the “pertinent patient information”. Nonetheless, it does mention clinical records carried by the patient (see col. 7, line 4). It would have been obvious to one of ordinary skill in the art at the time of the invention that the cited clinical record in the removable medium would have included pertinent patient information, for purposes of *personal identification* (e.g. name, age, date of birth).

***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- Argiro et al. [US 5,986,662] teaches a network server compatible with the DICOM protocol.
- Pinsky et al. [US 5,469,353] discloses image interpretation apparatus and method.
- Abe et al. [JP 11088589 A] teaches image processing unit and method.
- Takahashi [JP 11027680 A] teaches data processing system including image data conversion.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Angel L. Casiano whose telephone number is 703-305-8301. The examiner can normally be reached on 9:30-6:30 pm.

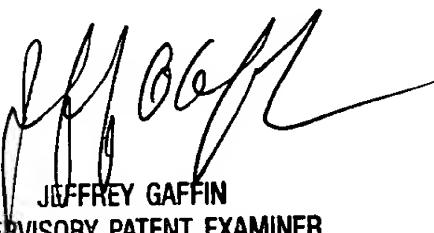
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on 703-308-3301. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

alc

19 May 2004



JEFFREY GAFFIN  
SUPERVISORY PATENT EXAMINER  
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